

REMARKS

Claims 1-3, 6, 8-10, 13, 15, 16, 18, and 19 remain pending. Applicants gratefully acknowledge the Examiner's indication that Applicants' arguments in the reply mailed May 9, 2005, are persuasive. Applicants also gratefully acknowledge the Examiner's withdrawal of previous grounds of rejection (Office Action at p. 2).

In the Office Action¹, the Examiner rejected claims 1-3, 6, 8-10, 13, 15, 16, 18, and 19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,949,877 to Traw ("Traw") in view of U.S. Patent No. 5,602,987 to Harari et al. ("Harari"), and further in view of U.S. Patent No. 5,450,366 to Watanabe ("Watanabe") and U.S. Patent No. 5,912,849 to Yasu et al. ("Yasu"). Applicants respectfully traverse the Examiner's rejection for the following reasons.

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-3, 6, 8-10, 13, 15, 16, 18, and 19 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

A *prima facie* case of obviousness has not been established because, among other things, neither *Traw*, *Harari*, *Watanabe*, nor *Yasu*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Claim 1 recites a combination including, for example,

A memory card comprising:

a storage portion including a public area which is capable of being accessed by an ordinary procedure, the public area including a rewritable public area and a read-only public area on which revocation information is registered ... ; and

a controller which determines whether or not use of the memory card by an electronic device ... is to be revoked, based on the revocation information registered on the read-only public area of the memory card and information sent from the electronic device, wherein the controller sends a key needed for a content exchange to the electronic device when the controller does not determine that use of the memory card by the electronic device is to be revoked, and wherein a content which is encrypted using the key is written on the rewritable public area of the memory card by the electronic device.

First, the Examiner concedes that "Traw does not explicitly disclose wherein the storage medium is a memory card, nor that the disclosed controller is embedded within the memory card" (Office Action at p. 4). The Examiner nevertheless alleges that "Harari discloses a memory card storage medium (col. 2, lines 54-59) comprising a controller embedded in the memory card (col. 5, lines 5-20 and Figure 2)" (Office Action at p. 4).

Second, the Examiner concedes that "[n]either Traw nor Harari disclose a storage portion including a secret area which is capable of being accessed by a specific secret procedure" (Office Action at p. 4). The Examiner nevertheless alleges that "Watanabe discloses a memory card comprising a secret area which is capable of being accessed by a specific secret procedure (col. 6, line 58 – col. 7, line 5)" (Office Action at p. 4).

Third, the Examiner concedes that “Traw, Harari, and Watanabe are silent regarding the public area of the memory card including both a rewritable public area and a read-only public area” (Office Action at p. 4). The Examiner nevertheless alleges that “Yasu discloses a memory card including both a rewritable public area and a read-only public area (col. 2, lines 20-67)” (Office Action at pp. 4-5).

Even assuming these assertions are true, *Traw, Harari, Watanabe, and Yasu*, taken alone or in combination, fail to teach or suggest at least

A memory card comprising:
a public area ... including a rewritable public area and a read-only public area on which revocation information is registered ... ; and
a controller which determines whether or not use of the memory card by an electronic device ... is to be revoked, based on the revocation information registered on the read-only public area of the memory card

(emphasis added) as recited by claim 1. That is, even assuming that *Harari* teaches a “a controller embedded in the memory card” and that *Yasu* teaches a “memory card including both a rewriteable public area and a read-only public area,” such teachings do not constitute a teaching or suggestion of determining whether to revoke access “based on the revocation information registered on the read-only public area of the memory card,” as recited by claim 1.

Because *Traw, Harari, Watanabe, and Yasu*, taken alone or in combination, fail to teach or suggest each and every element recited by claim 1, no *prima facie* case of obviousness has been established with respect to this claim. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Traw* in view of *Harari*, and further in view of *Watanabe* and *Yasu*.

Also with respect to claim 1, the Examiner has not shown that one of ordinary skill in the art would have been motivated to combine *Traw*, *Harari*, *Watanabe*, and *Yasu* in a manner resulting in Applicants' claimed invention. There is no motivation to combine the cited references to produce the claimed invention.

Moreover, the Examiner has used improper hindsight to combine *Traw*, *Harari*, *Watanabe*, and *Yasu* under 35 U.S.C. § 103(a). As M.P.E.P. § 2142 instructs, "the examiner must ... make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." The Examiner has not considered the claimed invention as a whole and has used impermissible hindsight to combine the alleged teachings of *Traw*, *Harari*, *Watanabe*, and *Yasu*.

For at least these additional reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Traw* in view of *Harari*, and further in view of *Watanabe* and *Yasu*.

Independent claims 2, 8, and 9, although of different scope, recite elements similar to elements recited by claim 1. Claims 3, 6, 10, 13, 15, 16, 18, and 19 depend from claims 1, 2, 8, and 9 and therefore include all of the elements recited therein. Therefore, at least for the reasons discussed above with respect to claim 1, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2, 3, 6, 8-10, 13, 15, 16, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Traw* in view of *Harari*, and further in view of *Watanabe* and *Yasu*.

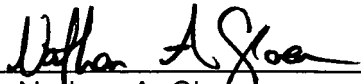
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 26, 2005

By: 
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